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EXAMINER

RUGGLES, JOHN S

ART UNIT PAPER NUMBER

1756

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/016,277	Applicant(s) WU, PETER HSIUEN	
Examiner John Ruggles	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 September 2003.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-63 is/are pending in the application.
4a) Of the above claim(s) 50-63 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 10 September 2003 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

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DETAILED ACTION

Election/Restrictions

Applicant's response filed 10 September 2003 as Paper No. 4 affirms the previous telephone election of Group I, claims 1-49. Accordingly, claims 50-63 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The facsimile copies of corrected drawings were received on 10 September 2003. These proposed drawings changes have overcome the previous objections by the draftsman and are now acceptable for re-submission in clean form (non-facsimile) with the response to this Office action.

Specification

The previous objections to the disclosure have been overcome by applicant's amendment filed on 10 September 2003 and are now withdrawn. Applicant's assistance is appreciated in clarifying the spelling of --bis (2,6-dimethoxybenzoyl)-2,4,4-trimethylpentyl phosphine oxide-- (emphasis added) as the photoinitiator compound included in IRGACURE™ 1700.

Claim Objections

The previous objections to claims 6 and 34 have also been overcome by amendment and are also now withdrawn. Again, applicant's assistance is appreciated in clarifying the spelling of

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--bis (2,6-dimethoxybenzoyl)-2,4,4-trimethylpentyl phosphine oxide-- (emphasis added), as noted above.

Claim Rejections - 35 USC § 112

While the previous rejection under the first paragraph and some portions of the previous rejection under the second paragraph of 35 U.S.C. 112 have been overcome by amendments to the claims and specification in view of applicant's remarks, the rejection remaining under the second paragraph of 35 U.S.C. 112 is stated below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The previous rejection of claims 11, 28, and 39 under the second paragraph of 35 U.S.C. 112 in regard to improper units for the radiation intensity has been overcome by the currently amended versions of these claims. However, in correcting the claim 28 units for the radiation intensity, the currently amended version of this claim now lacks an upper bound for the radiation intensity by reciting "of about 100 W/cm² to about W/cm²". But, because the upper bound was originally recited as "600 W/cm" and further in view of current amendments to the specification showing "600 W/cm²" (on pages 2-3 of the amendment), the current deletion of "600" is believed to be inadvertent and the recited phrase for the radiation intensity is interpreted to mean

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--of about 100 W/cm² to about 600 W/cm²--. Accordingly, claims 11, 28, and 39 are now treated on the merits, as shown below. However, currently amended claim 28 must still be amended in response to this rejection.

Claim Rejections - 35 USC § 102

The previous 35 U.S.C. 102(b) rejection of claims 1-4, 7-8, 13-15, and 17-18 as being anticipated by Maeda, et al. (US Patent 5,466,739) is now withdrawn because applicant's arguments filed 10 September 2003 are found to be partially persuasive in that Maeda does not specifically require actinic radiation curing using a photoinitiator in the peelable radiation curable maskant composition including a polymerizable acrylate. However, it would still have been obvious to substitute actinic radiation curing using an appropriate photoinitiator with the polymerizable acrylate radiation curable maskant, as shown by Sokol (US Patent 5,773,487), for the reasons set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda, et al. (US Patent 5,466,739) in view of Sokol (US Patent 5,773,487) further in view of Lake (US Patent 5,571,570), and further in view of Wright (US Patent 5,260,350).

Maeda teaches a peelable radiation curable maskant composition optionally including a polymerizable acrylate with talc or silica filler (instant claims 7-8) and a process of chemically milling a metal aircraft part using the maskant (column 1, lines 10-21, column 3, lines 51-60, and column 5, lines 48-51). Note that the polymerizable acrylate is understood to include diacrylate, urethane acrylate and/or urethane diacrylate (instant claim 4). At column 1, lines 33-34 and column 7, lines 28-31, the metal of the part is described as aluminum (Al), iron (Fe), titanium (Ti), and/or the like, which is understood to include alloys thereof (instant claim 2). The process of chemically milling the metal part involves: (1) coating the maskant onto the metal by spraying, rolling, or immersion (instant claim 15); (2) drying or curing the coating by far infrared rays; (3) scribing the maskant to allow peeling away of unneeded maskant portions; and (4) etching through the maskant for chemically milling selected portions of the metal substrate, optionally in plural separate stages of scribing additional portions of the maskant for removal and further etching through the maskant (column 7, line 33 to column 8, line 12, instant claims 1 and 17-18). The cured maskant film thickness is 100-800 μm , which correlates to 4-31 mils (column 7, lines 25-27, fully encompassing the 5-20 mils of instant claim 13). After etching, the peeling strength of 1 inch wide strips of maskant giving "good" results were measured in the range of 200-1,200 g/inch as shown in Table 2 (columns 11-12), which correlates to a peeling strength of 7-42 oz./inch (instant claim 14).

While teaching the use of a radiation polymerizable monomer in the category of acrylates for the maskant, Maeda does not specifically teach (1) curing with actinic radiation using a photoinitiator in the peelable radiation curable maskant composition including a polymerizable acrylate; (2) using at least one of the specific monomers of instant claim 5 in the peelable radiation curable maskant including a polymerizable acrylate; (3) using at least one of the specific photoinitiators of instant claim 6 in the peelable radiation curable maskant including a polymerizable acrylate; and/or (4) radiation curing of the acrylate coating at a rate of about 1-10 feet/minute.

However, combinations of these acrylate monomers and photoinitiators (instant claim 3) are known for substantially solvent free radiation curable acrylate coatings as shown by Sokol at column 3, line 44 to column 4, line 29 (instant claims 5-6). These coating combinations provide quick curing upon exposure to ultraviolet (UV) light, sunlight, or electron beams (column 2, lines 41-44, instant claim 9). In column 6, lines 1-8, UV light (e.g., having a peak spectral wavelength in the range of 180 nm to 420 nm, etc., which reads on instant claims 11, 28, and 39 for a UV radiation wavelength of about 200 nm to about 450 nm) can be generated using typical factory lighting, which is considered to include movable light sources (instant claim 10).

Furthermore, while Maeda and Sokol show actinic UV curing of a radiation polymerizable acrylate composition to form a peelable maskant using a UV radiation wavelength of about 180 nm to 420 nm, they do not specifically teach that the UV radiation source has an intensity of about 100 W/cm² to 600 W/cm². However, UV curing of a polymerizable acrylate coating composition at a wavelength in the range of 1800-4500 Å (180-450 nm) is known to be carried out with a high pressure mercury lamp as a UV radiation source having an intensity of

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30-400 W/cm², as shown by Lake at column 5, lines 48-56 in view of Example 2 at column 6, line 53 (which fully encompasses the UV radiation source intensity of 120-185 W/cm² found in instant claim 11). UV curing of a polymerizable acrylate coating composition using this radiation source provides good through cure, which is achievable over a surprisingly wide range of exposures, in order to ensure desirable crack resistance and provide a coating having uniquely combined properties of durability, scratch resistance, and flexibility (column 5, line 62 to column 6, line 8).

UV curing of an acrylate coating on a substrate moving relative to a UV radiation source at a specified rate in feet/minute in the range of 1-10 feet/minute is also known. Wright describes UV exposure curing of an acrylate coating moving past a medium pressure mercury vapor arc lamp at a line speed of 3 feet/minute for a UV curing exposure average intensity of 91.56 mW/cm² at column 11, lines 5-9 (which reads on a rate of 1-10 feet/minute recited in instant claim 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute any of the substantially solvent free radiation curable acrylate coating compositions (having a photoinitiator for curing by actinic or UV radiation) of Sokol for the radiation curable maskant including polymerizable acrylate in the process of Maeda with the lighting for curing as shown by Sokol in order to obtain quick curing of the polymerizable acrylate maskant. It would also have been obvious to have carried out the curing of the UV radiation polymerizable acrylate composition to form a peelable maskant, as shown by Maeda and Sokol, by using a UV radiation source having a wavelength of 180-450 nm and an intensity of 30-400 W/cm², as shown by Lake, for curing of an acrylate coating composition while

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relatively moving the acrylate coating past a UV radiation source at a line speed of 3 feet/minute, as described by Wright. This is because UV curing of a polymerizable acrylate coating composition using Lake's radiation source provides good through cure, which is achievable over a surprisingly wide range of exposures, in order to ensure desirable crack resistance and provide a coating having uniquely combined properties of durability, scratch resistance, and flexibility; and further because Maeda, Sokol, and Wright all relate to the same art of radiation curing of an acrylate coating composition.

Claims 16, 19-21, 26, 28-32, 35, 39, 40-42, and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda and Sokol in view of Lake, further in view of either Blake (US Patent 5,126,005) or Jaffe, et al. (US Patent 4,585,519), and further in view of Wright.

While teaching actinic UV curing of a radiation polymerizable acrylate composition using a UV radiation wavelength of about 180 nm to 420 nm to form a peelable maskant to a thickness of 4-31 mils (having a peeling strength of 7-42 oz./inch for a 1-inch wide strip) and chemical treatment of an Al, steel, or Ti metal aircraft part, Maeda and Sokol do not specifically teach (1) curing of the acrylate composition by a UV radiation source having a wavelength of 180-450 nm and an intensity of about 100 W/cm² to 600 W/cm², (2) masking both sides of the metal aircraft part, (3) subsequently resealing scribed cut lines of the mask before chemically milling, and (4) radiation curing of the acrylate coating at a rate of about 1-10 feet/minute.

The showing of Lake is discussed above.

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Blake shows coating both sides of a metal aircraft part with maskant layers and overcoating with a plastic film, selective removal of portions of the plastic and maskant layers, and subsequent chemical milling and anodizing of the metal part (column 3, line 7 to column 4, line 13).

Jaffe describes a process of chemically milling a metal aircraft part by masking the metal part (column 5, lines 50-53), scribing the mask with a pattern, marking the scribed cuts, resealing the scribed lines (column 9, lines 36-40), removing (e.g., by peeling, etc.) the scribed portions of the mask, and etching (optionally in separate steps of scribing and etching different portions of the metal part, column 9, lines 58-60). All surfaces of the metal part should be masked except those areas to be chemically milled (column 11, lines 19-24). The sealant may be the same material as that of the mask or any other sealant material, which is both compatible with the mask and capable of withstanding the etching step(s) (column 12, lines 30-33). Also, the sealant may be applied with a roller, brush, or other fluid dispenser as may be desired, depending on the flow characteristics of the sealant material (column 12, lines 33-37).

The description of Wright is discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform curing of the UV radiation polymerizable acrylate composition to form a peelable maskant, as shown by Maeda and Sokol, by using a UV radiation source having a wavelength of 180-450 nm and an intensity of 30-400 W/cm², as shown by Lake, and radiation curing at a rate of 3 feet/minute (which reads on the about 1-10 feet/minute of instant claim 40) for curing of an acrylate coating composition, as described by Wright. This is because UV curing of a polymerizable acrylate coating composition using Lake's radiation source provides

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good through cure, which is achievable over a surprisingly wide range of exposures, in order to ensure desirable crack resistance and provide a coating having uniquely combined properties of durability, scratch resistance, and flexibility. It would also have been obvious to combine the masking (having a peeling strength of 7-42 oz./inch for a 1-inch wide strip, instant claim 42) and chemical treatment (milling) taught by Maeda and Sokol with the double-sided masking and chemical treatment either shown by Blake (further coating of mask, then scribing, milling, and anodizing) or described by Jaffe (resealing scribed lines and milling). It would further have been obvious to apply the sealant material (e.g., by rolling, etc.) as described by Jaffe. This is because: (1) Maeda, Sokol, Lake, and Wright all relate to the same art of radiation curing for polymerizable acrylate compositions and (2) Maeda, Blake, and Jaffe all relate to the same art of masking and chemical treatment of a metal aircraft part.

Claims 22-23, 27, 33-34, 37-38 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of either Blake or Jaffe, and further in view of Sokol.

While teaching the use of a radiation polymerizable monomer in the category of acrylates for the maskant and/or sealant, Maeda and either Blake or Jaffe do not teach (1) at least one of the specific monomers of instant claims 22 and 33, (2) at least one of the specific photoinitiators of instant claims 23 and 34, and (3) curing the line sealant by UV, black light, or visible radiation.

However, combinations of these acrylate monomers and photoinitiators are known for radiation curable acrylate coatings, which are quickly cured by exposure to UV light or sunlight as shown by Sokol and discussed above.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute any of the radiation curable acrylate coating compositions, which are cured by UV light or sunlight as shown by Sokol for the maskant (having a peeling strength of 7-42 oz./inch for a 1-inch wide strip, instant claims 48-49) and/or sealant in the process of Maeda and either Blake or Jaffe in order to obtain quick curing of the polymerizable acrylate maskant and/or sealant as shown by Sokol.

Claims 24-25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of either Blake or Jaffe, further in view of Sokol, and further in view of Snowwhite, et al. (US Patent 6,136,880).

While teaching use of radiation polymerizable acrylate and photoinitiator combinations for the maskant and/or sealant, Maeda, either Blake or Jaffe, and Sokol do not teach the addition of a wax and a triethanolamine synergist.

Snowwhite discloses radiation curable and removable protective coating compositions having many of the same acrylate monomer(s) and/or photoinitiator(s) as shown by Sokol and discussed above along with additives of wax to exclude oxygen (O₂) and at least one accelerator or synergist including triethanolamine, which also helps to overcome the inhibiting effect of O₂ (column 16, line 58 to column 17, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute any of the radiation curable acrylate coating compositions of Sokol along with the additives of wax and triethanolamine synergist as disclosed by Snowwhite for the maskant and/or sealant in the process of Maeda and either Blake or Jaffe in order to obtain quick

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curing of the polymerizable acrylate maskant and/or sealant as taught by Sokol and also to overcome the inhibiting effect of O₂ as disclosed by Snowwhite.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda and Sokol in view of either Blake or Jaffe, and further in view of Gnanamuthu, et al. (US Patent 4,716,270).

While teaching masking, mechanically scribing (e.g., with a knife, etc.), subsequent coating or sealing, peeling away cutout maskant, and chemical treatment, Maeda and Sokol and either Blake or Jaffe do not teach performing the scribing step alternatively with a laser.

Gnanamuthu teaches masking of a metal aerospace part, scribing a pattern in the maskant, peeling away cutout portions of the maskant, repairing cut edges of the maskant by resealing to the metal (e.g., tacking the maskant back down to the metal by solvent wetting, etc.), chemically milling the metal through the maskant pattern, and removing remaining maskant (column 1, lines 28-58). The maskant scribing is alternatively performed with a laser (column 4, lines 3-4). Laser scribing of the maskant reduces labor costs, avoids scoring of the metal underlying the maskant, and does not adversely affect the adhesion of the remaining maskant so that there is no premature lift-off or peel-back of the remaining maskant before chemical milling (column 2, lines 35-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute laser scribing as taught by Gnanamuthu for the mechanical scribing of the maskant as taught by Maeda and Sokol and either Blake or Jaffe, because (1) Maeda and Sokol both relate to the same art of radiation curing for polymerizable acrylate compositions and (2) Maeda, Blake, and Jaffe all relate to the same art of masking and chemically milling a metal

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aircraft or aerospace part. In addition, laser scribing of the maskant reduces labor costs, avoids scoring of the metal underlying the maskant, and does not adversely affect the adhesion of the remaining maskant so that there is no premature lift-off or peel-back of the remaining maskant before chemical milling as pointed out by Gnanamuthu.

Response to Arguments

Applicant's arguments filed 10 September 2003 have been fully considered but they are either only partially persuasive or moot in view of the new ground(s) of rejection necessitated by amendment. The previous objections and some of the previous grounds of rejection have been overcome by the amendment. The remaining rejections and those necessitated by amendment are stated above.

As stated above, Sokol and Maeda are combined because they both relate to the same art of radiation curable acrylate coating compositions. The Sokol substantially solvent free radiation curable acrylate coating combination of polymerizable acrylate monomers and photoinitiators is quickly cured by actinic or UV light. This gives one of ordinary skill in the art motivation to substitute the Sokol radiation curable acrylate coating composition for the radiation curable acrylate coating composition of Maeda, with the expectation that the Sokol radiation curable acrylate coating would also yield a peelable maskant functional in the process of Maeda.

The other reasons for finding claims 1-49 obvious over the cited prior art of record are explained above.

Conclusion

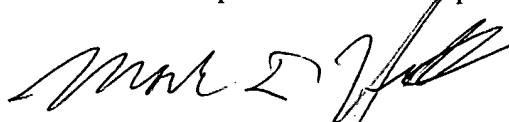
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Ruggles whose telephone number is 703-305-7035. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700


John Ruggles
Examiner
Art Unit 1756